

## UNITED ST. S DEPARTMENT OF COMMERCE Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		АТТ	ATTORNEY DOCKET NO.	
08/647,1	14 05/09/9	6 GUGLIELMI		G	M203D-D	
-	÷	QM12/0826	7	EXAMINER		
DANIEL L DAWES 5252 KENILWORTH DRIVE		E ,	[	COHEN .	PAPER NUMBER	
HUNTINGT	ON BEACH CA	92649		3739		

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks** 

08/26/99

## Application No.

08/647,114

Approant(s)

Guglielmi et al

Examiner

Office Action Summary

Lee S. Cohen

Group Art Unit 3739



⊠ Responsive to communication(s) filed on <u>Dec 29, 1998</u>	·						
☑ This action is FINAL.							
☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.							
A shortened statutory period for response to this action is set to exis longer, from the mailing date of this communication. Failure to rapplication to become abandoned. (35 U.S.C. § 133). Extensions 37 CFR 1.136(a).	espond within the period for response will cause the						
Disposition of Claims							
X Claim(s) 25-34	is/are pending in the application.						
Of the above, claim(s)	is/are withdrawn from consideration.						
Claim(s)	is/are allowed.						
	is/are rejected.						
☐ Claim(s)							
☐ Claims							
Application Papers							
$\square$ See the attached Notice of Draftsperson's Patent Drawing Re	eview, PTO-948.						
☐ The drawing(s) filed on is/are objected	to by the Examiner.						
The proposed drawing correction, filed on	is □approved □disapproved.						
$\square$ The specification is objected to by the Examiner.							
$\hfill\Box$ The oath or declaration is objected to by the Examiner.							
Priority under 35 U.S.C. § 119							
☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).							
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been							
received.							
☐ received in Application No. (Series Code/Serial Number)							
$\square$ received in this national stage application from the international Bureau (PCT Rule 17.2(a)).							
*Certified copies not received:							
Acknowledgement is made of a claim for domestic priority u	nder 35 U.S.C. § 119(e).						
Attachment(s)							
Notice of References Cited, PTO-892							
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s)	•						
☐ Interview Summary, PTO-413							
□ Notice of Draftsperson's Patent Drawing Review, PTO-948							
Notice of Informal Patent Application, PTO-152							
SEE OFFICE ACTION ON THE	EQUI OWING BACES						

Serial Number: 08/647,114 Page 2

Art Unit: 3739

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25-34 are rejected under the judicially created doctrine of double patenting over claims 13-23 of U. S. Patent No. 5,122,136 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a wire for forming an occlusion

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The terminal disclaimer filed on 1/13/98 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Pat. No. 5,122,136 has been reviewed and is NOT accepted.

Serial Number: 08/647,114 Page 3

Art Unit: 3739

The assignee has not established its ownership interest in the application or patent, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

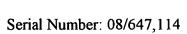
No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of assignee's knowledge and belief title is in the assignee seeking to take action (37 CFR 3.73(b)).

The arguments presented in the amendment filed December 29, 1998 are not acceptable.

A new terminal disclaimer with the required information must be filed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Art Unit: 3739

Any inquiry concerning this communication should be directed to Lee S. Cohen at telephone number (703) 308-2998.

Lee Cohen Primary Examiner